

Remarks

Claims 1-35 and 43-50 have been cancelled; claim 36 and the title has been amended; and claims 51-56 have been added, leaving claims 36-42 and 51-56 pending in the application. The amendment to claim 36 and new claims 51-56 do not constitute new matter as they are supported at, for example, pages 4 and 5 of the originally filed specification. Reconsideration of the application in view of the amendments and the remarks to follow is requested.

The previously pending claims stand rejected as being anticipated by U.S. Patent 6,313,360 to Wilson et al. (Wilson) and/or obvious in view of Wilson and U.S. Patent 6,316,682 to Nakada et al. (Nakada). The pending claims are allowable in view of the cited references for at least the reason the cited references neither teach nor suggest all the elements of the pending claims.

Referring to claim 36, as amended, claim 36 recites a process for preparing halogenated alkanes whereby a haloalkane and a haloalkene are reacted in the presence of both an alkyl phosphate and an elongated iron mass to produce a halogenated alkane. (emphasis added). The cited references neither teach nor suggest a reacting a haloalkane and haloalkene in the presence of both an alkyl phosphate and an elongated iron mass.

Recall "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). **"The identical invention must be shown in as complete**

detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d

1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). The cited references cannot anticipate claim 36 for at least the reason claim 36 recites an elongated iron mass and the cited references fail to teach or suggest an elongated iron mass.

For example, Wilson describes a process that comprises reacting carbon tetrachloride and vinyl chloride in the presence of a catalyst mixture comprising organophosphate solvent, iron metal and ferric chloride. (Abstract of Wilson). When referring to the iron metal Wilson describes that metallic iron in any form may be used, but powder is preferred. Wilson goes on to describe that the metallic iron may be added to the reactor by any means, but powder slurry in carbon tetrachloride is preferred. (Col. 3, lines 1-5). Wilson makes no reference to the use of an elongated iron mass as recited in claim 36. The metallic iron described by Wilson cannot be considered an elongated iron mass for at least the reason that Wilson recites a preferred form of metallic iron as powder, but makes no mention of wire. Nor can the use of an elongated iron mass be considered as obvious in view of Wilson, for at least the reason that Wilson neither teaches nor suggests the use of an elongated iron mass when Wilson describes and suggests a powdered form of metallic iron. Nor is there an expectation of a successful process using an elongated iron mass as required in order to render claim 36. As claim 36 is not anticipated by the cited references nor can a prima facie case of obviousness be established with respect to claim 36, claim 36 is allowable.

Claims 37-42 and 52-55 depend from claim 36 and are allowable for at least the reasons stated above regarding claim 36 as well as other patentable reasons.

For example, claim 51 recites the process of claim 36 within a reactor, with the reactor being provided a mixture comprising the haloalkane, the haloalkene, and the alkyl phosphate. The cited references neither teach nor suggest a mixture with these features.

As another example, claim 52 recites the process of claim 51 with the mixture comprising at least two components. Claim 52 goes on to recite that the first component consists of the haloalkane and the haloalkene, and the second component consists of the alkyl phosphate with the mixture comprising about 3% of the second component. The cited references neither teach nor suggest mixtures with these amounts of components.

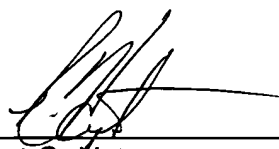
As still another example, claim 55 recites the process of claim 36 further including removing at least a portion of the halogenated alkane from the within the reactor, with the elongated iron mass remaining in the reactor during the removing. The cited references neither teach nor suggest these features. More particularly, Wilson goes into great detail in describing the recycling of iron powder from the reactor effluent.

Claims 36-42 and 51-56 are pending in the present application. This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested.

Respectfully submitted,

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By: _____


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